

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Brad W. BLUMBERG et al.

Examiner: Figueroa, Marisol

Serial No. 10/644,060

Art Unit: 2617

Filed: August 20, 2003

Confirmation No.: 4358

For: **SYSTEM AND METHOD FOR PROVIDING INFORMATION BASED ON
GEOGRAPHIC POSITION**

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ARGUMENTS IN SUPPORT OF PRE-APPEAL REQUEST FOR REVIEW

Applicants submit the following arguments in support of the Pre-Appeal Brief Request for Review filed herewith.

I. Claim Rejections

Claims 1-11 and 18-23 stand rejected under 35 U.S.C. 103(a).

II. Independent Claims 1 and 7 and their respective Dependent Claims are Patentable over Wharton and Kimoto

The Examiner has rejected independent claims 1 and 7 under 35 U.S.C. §103(a) as being unpatentable over *Wharton* in view of *Kimoto*. The Applicants respectfully submit that the references are not properly combinable, and therefore the Examiner has failed to establish a *prima facie* case of obviousness of independent claim 1.

The Examiner asserts that *Wharton* discloses a method of retrieving location-centric information as in claim 1, except *Wharton* does not expressly disclose that the geographic location is associated with a location of the electronic device. The Examiner further asserts that that it would have been obvious to a person of ordinary skill in the art to modify *Wharton* to

associate the identified geographic location with the location of the electronic device of *Kimoto*. The Applicants respectfully disagree with this assertion. The Applicants respectfully submit that there is *no motivation to combine the teachings of Kimoto with Wharton*.

Wharton is directed at a method and system for synchronizing data between a mobile interface device, such as a personal digital assistant (PDA), and an interactive terminal, such as a television. The system in *Wharton* provides data from a processor 18 to the interactive terminal 14 and/or the mobile interface device 12, via a set-top transceiver device 16. *Wharton* discloses that the mobile interface device 12 communicates with the transceiver device 16 with either wireless infra-red technology or a wireline communication. In each of these modes of communication, the mobile interface device 12 must be in close proximity to the transceiver device 16. Thus, as the Examiner has conceded, *Wharton* does not disclose or suggest that the mobile interface device 12 can be associated with the geographic location as recited in claim 1.

Kimoto is directed at a mobile communication system that includes multiple mobile terminals 1 and an information center 2. Position data of the mobile terminals 1 can be communicated to the information system 2 and the information system 2 can send information relating to the position of the mobile terminal back to the mobile terminal 1. The Applicants submit that there would have been no motivation to combine the mobile terminal location information feature of the *Kimoto* system with the system of *Wharton*. In fact, *Wharton* expressly provides for a system that can only be used without actually being present at the geographic location being queried. For example, *Wharton* discloses that the invention is aimed at reducing the necessity of a prospective home buyer from having to travel to a property to find out information about that property (see, for example, col. 4, ll. 42-46). Also, as stated above, the mobile interface device 12 of *Wharton* can only communicate with the transceiver device 16 when in close proximity to the transceiver device 16. Thus, *Wharton* teaches away from the geographic location being associated with the location of the electronic device. To combine the mobile terminal location information feature of the *Kimoto* system with the *Wharton* system would be contrary to the teachings of *Wharton* and would eviscerate the intended purpose of the *Wharton* system.

The Examiner asserts in the Advisory Action that *Wharton* includes aspects “aimed to reducing database browsing, comparison of multiple selection criteria, reducing human interaction, etc., and therefore does not limit the invention to only being used without being present at the geographic location.” The Applicants strongly disagree with this assertion. *Wharton* does not disclose or suggest in any way that the mobile terminal device can be used at the geographic location at issue. In fact, as stated above, the device is configured to be used prior to traveling to the geographic location. In addition, the mobile interface device 12 of *Wharton* must be in close proximity to the transceiver device 16 to function. *Wharton* does not disclose or suggest having the transceiver device 16 positioned at the geographic location and then using the mobile interface device 12 at that geographic location. Rather, *Wharton* teaches using the device at, for example, a user’s home, where the transceiver device 16 is located, to locate a prospective geographic location that the user may wish to visit.

The Examiner also asserts in the Advisory Action that *Wharton* suggests the wireless communication device “may support a transportation application like global positioning data to obtain instructions for how to get to an address from a current location and does not discourage using the location of the mobile terminal to tailor the search for real estate properties.” Even if *Wharton* does suggest what the Examiner asserts, this still does not suggest that the mobile interface device 12 is located at the geographic location that is the subject of the search. The Examiner’s assertion merely says that the mobile interface device 12 of *Wharton* can be used to search for and provide directions to a geographic location. If the mobile interface device 12 were intended to be used at the geographic location, there would be no need to seek out directions to that geographic location. Furthermore, the Examiner’s assertion that *Wharton* does not discourage using the location of the mobile terminal to tailor the search for real estate properties is of no consequence, as the test is not whether a reference discourages the use of the device in some manner, but rather the test is whether there is a suggestion or motivation to combine the cited references.

Thus, based on the above, it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of *Wharton* by adding the mobile terminal location information feature of the *Kimoto* system. The Examiner’s combination of *Wharton* and

Kimoto is improper and the Examiner therefore has not established a *prima facie* case of obviousness of independent claim 1. Accordingly, claim 1 and its dependent claims, claims 2-6 and 18-20, are allowable.

Independent claim 7 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wharton* in view of *Kimoto*. The Examiner concedes that *Wharton* does not disclose or suggest “providing information related to a geographic location associated with a position of an electronic device to an information system,” as recited in claim 7. For the same reasons as stated above for claim 1, the Applicants respectfully submit that the Examiner has impermissibly combined *Wharton* and *Kimoto* to make up for this deficiency, as there would have been no motivation to combine the mobile terminal location information feature of the *Kimoto* system with the system of *Wharton*. Accordingly, claim 7 and its dependent claims, claims 8-11 and 21-23, are allowable.

CONCLUSION

For the foregoing reasons, the Applicants respectfully request that the panel of Examiners review the final rejection and issue a decision that the pending claims are allowed.


The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1283.

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